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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/930,449 10/07/97 ABE

H JAO-39514

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MM12/0817

EXAMINER

RAO.S

ART UNIT

PAPER NUMBER

2814

DATE MAILED:

08/17/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
08/930,449

Applicant(s)
Abe et al.

Examiner
Steven Rao

Group Art Unit
2814



☒ Responsive to communication(s) filed on Oct 7, 1997

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire One (1) month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-62 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☐ Claim(s) _____ is/are rejected.

☐ Claim(s) _____ is/are objected to.

☒ Claims 1-18,20-23,25-28,30-33,35-38,40-44,46-49 & 56-62 are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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DETAILED ACTION

Election/Restrictions

1. Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in response to this action, to elect a single invention to which the claims must be restricted.

Group 1, claim(s) 1-18,20-23,25-28,30-33,35-38,40-42,46-49 &56-62 are drawn to a method of forming a crystalline film in class 438 subclass 158.

Group II , claim(s)19,24,29,34,39,44,50- 55 , drawn to a high energy supply apparatus for use with an object material in class 118 subclasses 723Fe and 723 MP.

2. The inventions listed as Groups do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: (1) the recited apparatus is not specifically designed for carrying out the claimed process. The apparatus claims are not limited to carrying out the said process but can be used for carrying out any process. Therefore under this test the two groups do not form a single inventive concept under PCT Rule 13.1 (2) The apparatus may be considered “specifically designed for carrying out” the process if the contribution over the prior art of the

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apparatus corresponds to the contribution the process makes over the prior art. Herein the apparatus claimed may contribute over the prior art in the high energy supply apparatus area and will be compared with existing high energy supply apparatuses to determine its contribution over the prior art. Whereas the process claims relate to the formation of a crystalline film and its contribution over the prior art will be determined by comparing it with existing methods of forming crystalline films. Therefore the apparatus and process do not make corresponding contributions but in fact totally different contributions in separate and distinct arts. Therefore under either of the available afore mentioned tests there cannot be a unity of the two separate apparatus and process inventions.

3. Because these inventions are distinct for the reasons given above and further have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

4. Applicant is advised that the response to this requirement to be complete must include an election of the invention to be examined even though the requirement is traversed.

5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventor ship must be amended in compliance with 37 CFR 1.48 (b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventor ship must be accompanied by a petition under 37 CFR 1.48 (b) and by the fee required under 37 Cfr 1.17 (I).

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6. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Steven H. Rao whose telephone number is (703) 306-5945. The fax number is (703) 308-7722 or -7724.

7. Papers related to this application may be submitted directly to Art Unit 2814 by facsimile transmission at the above mentioned fax numbers.

8. Any inquiry of a general nature or relating to the status of this application should be directed to the Technology center 2800 receptionist at (703) 308-0956.


Olik Chaudhuri
Supervisory Patent Examiner
Technology Center 2800